SUPREME COURT, U.S.
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MICHAEL RODAK, JR., CLERK

No. 71-1462

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1971

SOLO CUP COMPANY,

Petitioner,

v.

ILLINOIS TOOL WORKS, INC.,

Respondent.

PETITIONER'S REPLY IN SUPPORT OF ISSUANCE OF WRIT OF CERTIORARI

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I.

The Impossibility of a Conflict between Circuits was Engineered by Respondent

The fact that Respondent might have brought its many lawsuits in a number of different judicial circuits merely emphasizes that, having had that option, respondent elected to bring them all in one judicial *district.*

The obvious reason was its earlier success there, buttressed by the "related case rule" (Rule 10(B)(5) of the Northern District of Illinois) under which Respondent could, and did, even choose the same trial judge. The industry was not only thus concentrated in one circuit, it was consigned by the Respondent to a single judge.

Whether such assignment of cases for trial *seriatim* to the same judge is consistent with justice, or with its "order-

ly administration" (Respondent's brief, P. 4), is not a question raised by the Petitioner on its petition. The result of that assignment, however, more firmly precludes a conflict between circuits than in any of the cases cited in the petition.

II.

The Decision of the Court of Appeals Conflicts, and that of the District Court Comports, with the Policy of the Patent Law

It is undisputed that there was a public use of the cup of the '213 patent before the modification of the '360 patent was conceived.

The Respondent's proposition that 35 U.S.C., § 102(b) bestowed its one-year grace period to allow an inventor to modify an invention already in public use, and to patent the modification, is asserted in its brief without support of authority (PP. 6, 7).

Decisions of this Court, to the contrary, would toll the commencements of that period for any bona fide experimentation, even in public (*Elizabeth* v. *Pavement Co.*); but when there has been a "public use" in the legal sense, as in this case, there is no authority that holds that subsequent modification is protected by the grace period to which the subject matter in public use is entitled. As the District Court pointed out, the one-year period to which the '213 cup was entitled did not shelter the '360 cup, which came later, was different, and had its own one-year grace period.

Respondent's further argument (P. 9) that the only effect of the public use of Section 102(a) upon the unobviousness requirement of Section 103, when applied to the inventor's own modification, is merely to demand "origi-

nality", i.e., to prevent the patenting of an invention not one's own, would strip Section 102(f) of its one and only purpose. Section 102(f) reads:

> "A person shall be entitled to a patent unless:
> (f) he did not himself invent the subject matter sought to be patented,"

By interpreting Section 102(a) as the mere echo of Section 102(f), the decision of the Court of Appeals conflicts on its face with the Patent Statutes.

III.

Graham v. Deere has Truly Been Circumvented

A lesser standard of invention than that of Section 103, as interpreted in *Graham* v. *Deere,* is the necessary result of the exemption created by the decision of the Court of Appeals in this case, as indeed the district judge recognized when he declined to grant such an exemption.

If the Court of Appeals had held the patentee subject along with all others to the prior art effect of his own earlier informing public use, but exempt from Section 103's requirement of unobviousness, the repudiation of *Graham* v. *Deere* would have been undeniable. Holding him exempt from the prior art effect of his own earlier informing public use (as the 7th Circuit here did) in judging whether his modification was unobvious under Section 103 had exactly the same results.

Thus, whether *Graham* v. *Deere* be regarded as repudiated or merely circumvented, a lesser kind of patent than that prescribed by this Court in the *Deere* case has here been approved as also being in the public interest.

Such a landmark should be reviewed by the Supreme Court.

IV.

CONCLUSION

For the reasons advanced in its petition and here, Petitioner respectfully prays the issuance of the writ.

Dated: May 23, 1972

Respectfully,
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